UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,620	04/19/2001	David B. Orchard	CA920000010US1	3584

		EXAMINER
7590	01/06/2005	RUTTEN, JAMES D

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ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2004*.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,11,12,17,19-22,24-29,31,32,37 and 38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,11,12,17,19-22,24-29,31,32,37 and 38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 April 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Acknowledgement is made of Applicant's amendment dated 13 September 2004,

responding to the 4 June 2004 Office action provided in the rejection of claims 1-36, wherein

claims 1, 9, 17, 22, and 29 have been amended, claims 2, 10, 13-16, 18, 23, 30, and 33-36 have

been canceled, and new claims 37 and 38 have been added. Claims 1, 3-9, 11, 12, 17, 19-22, 24-

29, 31, 32, 37, and 38 remain pending in the application and have been fully considered by the

examiner.

Applicant's arguments with respect to the rejection of the claims have been considered

but are moot in view of the new grounds of rejection.

2.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Response to Arguments

3.   Applicant argues on page 10 paragraph 3 of the amendment that "transformation

language is not a recited feature of applicant's invention." However, claim 6 clearly recites

"implemented in a transformation language," and the recitation of "transformation language" is

further found in claims 7, 26, and 27. If "transformation language" is not intended to be a recited

feature of applicant's invention, it should be removed from claims 6, 7, 26, and 27.

4.   Applicant argues on page 10 paragraph 4 that they do not know how to represent the

implementation of a transformation language in the drawings. The examiner suggests simply

modifying block 16 in FIG. 1 to incorporate either the phrase "transformation language" or

"XSL", enclosed in parentheses beneath the words "Code Generation Templates". However, if

this is not a feature of applicant's invention, it is not required to be represented in the drawings.

5.   Applicant argues on pages 11 and 12 that the use of "JAVA" in the claims is not

indefinite. On page 12, Applicant poses the question: "given a claim recitation of a "JAVA

class", is it possible to determine with reasonable particularity whether an accused method or

device falls within the scope of the claim"? 35 U.S.C. 112 requires that the claims particularly

point out and distinctly claim the subject matter which the applicant regards as his invention. As

pointed out in the previous Office action, a trademark or trade name is used to identify a source

of goods, and not the goods themselves. While the claims do not expressly recite a "source" of

goods, the use of a trademark is nonetheless restricted by its definition: A trademark is a word,

phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies

and distinguishes the source of the goods of one party from those of others. Thus, a trademark or

trade name does not identify or describe the goods associated with the trademark or trade name.

In this context, the phrase "JAVA class" could be interpreted to mean --class originating from

Sun Microsystems--, or it could be interpreted to mean --interpreted object-oriented

programming language class conforming to the Sun Microsystems JAVA programming language

specification--. Further, JAVA is not simply a programming language, but encompasses a wide

range of products. From the Sun Microsystems website: "Java technology is a portfolio of

products that are based on the power of networks and the idea that the same software should run

on many different kinds of systems and devices." The use of the trademark JAVA is not limited

to the programming language. Thus, the scope of the claim is indefinite.

Drawings

6.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the "transformation language" and/or

"XSL" must be shown or the feature(s) canceled from the claim(s). No new matter should be

entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the

drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

and informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

8.   Claims 4, 9, 12, 20, 24, 29, and 32 contain the trademark/trade name JAVA. Where a

trademark or trade name is used in a claim as a limitation to identify or describe a particular

material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second

paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is

uncertain since the trademark or trade name cannot be used properly to identify any particular

material or product. A trademark or trade name is used to identify a source of goods, and not the

goods themselves. Thus, a trademark or trade name does not identify or describe the goods

associated with the trademark or trade name. In the present case, the trademark/trade name is

used to identify/describe an interpreted object-oriented programming language class conforming

to the Sun Microsystems JAVA specification and, accordingly, the identification/description is

indefinite.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1, 39, 11, 12, 17, 19-22, 24, 25-29, 31, 32, 37, and 38 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication US 2004/0123302 A1

by Lo et al. (hereinafter "Lo") which claims priority to earlier filed application number

09/483,069 filed on January 14, 2000.

The applied reference has a common inventor with the instant application. Based upon

the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate

showing under 37 CFR 1.131.

In regard to claim 1, Lo discloses:

A method of data access code generation in an object-oriented programming

environment (See page 1 paragraph [0011]), *comprising:*

a) describing a data object in a data object description document, said data

object description document conforming to a data object document type definition, said

data object document type definition defining at least one application programming

interface (API) for providing access to backend data at runtime See page 5 paragraph

[0107]:

> First the author must use the **data model** that exists in the backend to create the **data object**
>
> **description XML document**. All data object description documents must **conform to a single**
>
> **DTD** which the Data Access Code Generator supports. The elements and attributes defined in the
>
> DTD depend on the **backend access APIs**.

b) applying at least one code generation template to said data object description

document, said at least one code generation template including at least one data access

API call for at least one corresponding API for providing access to backend data at

runtime, said API defined by said data object document type definition;

> See page 6 paragraphs [0117] and [0118]:
>
> The code generation templates in FIG. 4 describe the code that is generated when the code
>
> generation routine is invoked. The code generation routine takes the **code generation template**
>
> and the **data object description XML** as inputs and produces Java source code. The code
>
> generation template contains the following: [0118] **API calls** for the **backends** that are **supported**
>
> **in the DataObject.dtd."**

c) generating code in an object-oriented programming language, said code

embodying at least one data access class to provide access to said backend data at

runtime using said at least one data access API call; said code being generated

automatically as output from said at least one code generation template applied to said

data object description document. See page 6 paragraphs [0117] and [0118] as cited

above.

In regard to claim 3, the above rejection of claim 1 is incorporated. Lo further

discloses a data access code generator routine in paragraph [0117].

In regard to claim 4, the above rejection of claim 1 is incorporated. Lo further

discloses JAVA class in paragraph [0095].

In regard to claim 5, the above rejection of claim 1 is incorporated. Lo further

discloses XML in paragraph [0017].

In regard to claims 6 and 7, the above rejection of claim 1 is incorporated. Lo

further discloses the use of XSL in paragraph [0056]. XSL is a transformation language.

In regard to claim 8, the above rejection of claim 3 is incorporated. Lo further

discloses *wherein said data access code generator takes said data object description*

document and said at least one code generation template as inputs and outputs said at

least one data access class. See paragraph [0017] for details.

In regard to claim 9, all limitations have been addressed in the above rejections of

claims 1, 4, and 5.

In regard to claims 11 and 12, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejections of claims 3 and 8, respectively.

In regard to claim 17, Lo discloses an apparatus on page 1 in paragraph [0011]. All further limitations have been addressed in the above rejection of claim 1.

As per claim 19, the above rejection of claim 17 is incorporated. All further limitations have been addressed in the above rejections of claims 1 and 8.

As per claims 20, and 21 the above rejection of claim 17 is incorporated. All further limitations have been addressed in the above rejections of claims 4 and 5, respectively.

In regard to claim 22, Lo discloses a program product on page 11, claims 9-11. Lo further discloses personal computers (page 3 paragraph [0058]) which inherently use memory, otherwise the processor would be unable to load programs. All further limitations have been addressed in the above rejection of claim 1.

As per claims 24-28, the above rejection of claim 22 is incorporated. All further limitations have been addressed in the above rejections of claims 4-8, respectively.

In regard to claim 29, all limitations have been addressed in the above rejection of claim 22.

As per claims 31 and 32, the above rejection of claim 29 is incorporated. All further limitations have been addressed in the above rejections of claims 3 and 8, respectively.

As per claim 37, the above rejection of claim 1 is incorporated. Lo further discloses:

d) modifying said data object description document; and

e) regenerating said code embodying said at least one data access class, said code being regenerated automatically as output from said at least one code generation template applied to said modified data object description document.

See page 7 paragraph [0134] for details.

As per claim 38, the above rejection of claim 22 is incorporated. All further limitations have been addressed in the above rejection of claim 37.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The

examiner can normally be reached on M, T, Th, F 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr

TUAN DAM
SUPERVISORY PATENT EXAMINER